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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/584,344

06/23/2006

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EXAMINER

NELSON, MICHAEL B

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

12/14/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/584,344	Applicant(s) HOSHINO ET AL.	
	Examiner MICHAEL B. NELSON	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 10-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

1. Applicant's amendments filed on 09/10/09 have been entered. Claims 1 and 3-9 are currently under examination on the merits. The previous 112 2nd paragraph rejections have been withdrawn because of applicant's amendments. The previous objections to the drawings are also withdrawn because of applicants' amendments.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

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the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 3-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uyama et al. (U.S. 5,700,550) in view of Nakasone (JP 11-198537), see attached human translation and further in view of Takeuchi et al. (U.S. 4,856,857).

6. Regarding claims 1, 3, 4 and 6-9, Uyama et al. discloses an anti-counterfeit discrimination medium made up of a transparent multilayer film having layers of different refractive index (C5, L60-C6, L20). A breakable print recording layer, 18, is disclosed to be selectively separated from the overall discrimination medium at certain locations (Fig. 4 and 6, C8, L35-C9, L30). A color print layer is disclosed, 12 or 28, (Fig. 1, 15-17, C5, L15-30 and C17, L35-C18, L10), as having the same color as the multilayer film. A hologram layer, 4, is disclosed (C5, L15-30). The separation of the layer 18 is disclosed as occurring during the peeling of the structure off of the article (C8, L35-C9, L10). In Fig. 9A and 9B an embodiment is shown in which two separate-able layers, 18 and 16, are included on both sides of the multilayer film, 10. The layers 18 and 16 are considered print recording layers in that they have printed material (i.e. at least color layer 12) attached to them, directly or indirectly, in their unseparated state.

7. Uyama et al. does not explicitly disclose that the breakable print layer contain a metal or alloy though the reference does disclose a metal layer in general, 34, in Fig 19 (C19, L10-C20, L15) used for its optical reflection properties. Uyama et al. does not disclose that the metal layer is the breakable layer. Nakasone discloses that in the field recording information onto a substrate

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with destructible layers (as in the hologram of Uyama) it is known to use thermosensitive destruction layers containing metal ([0004] and [0006]). It would be obvious to have used the low melting point metals of Nakasone in the destructive layer of Uyama in order to make the layer thermosensitively breakable from exposure to a laser ([0023]).

8. While Uyama et al. discloses a hologram layer, it does not explicitly disclose that the hologram layer be of the type that changes color depending on viewing angle. While one having ordinary skill in the art would have independently found it obvious to have used all types of holograms for the hologram of Uyama (including color changing holograms), Takeuchi discloses that in security images "rainbow" type holograms were one of many known types of holograms for providing anti-counterfeiting properties (C4, L40-55). Hence it would have been obvious to have made the hologram of Uyama color changing in order to render the image harder to copy.

9. Regarding claim 5, Uyama et al. discloses all of the limitations as set forth above. Additionally, Uyama et al. discloses that the base layer, 82, in Fig. 16 A and B, which is adjacent to the multilayer film, is a black layer (C18, L30-35). While layer 82 is not an adhesive layer it is the background against which the multilayer transparent film, 10, is to be observed in the same way as the adhesive layers of the other embodiments and therefore one having ordinary skill in the art would have found it obvious to have provided the adhesive layers with black pigment for the purposes of enhancing contrast in the same way that the black layer 82 enhances contrast in the embodiment of Fig. 16A and 16B.

Response to Arguments

10. Applicant's arguments of 09/10/09 are considered moot in light of the new grounds of rejection which were necessitated by applicant's amendments.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL B. NELSON whose telephone number is (571) 270-3877. The examiner can normally be reached on Monday through Thursday 6AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David R. Sample/
Supervisory Patent Examiner, Art Unit 1794

/MN/
12/02/09